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OFFICE OF PETITIONS

In re Patent of	:	
Colvin et al.	:	
Patent No. 6,066,160	:	
Issue Date: 05/23/2000	:	
Application No 09/198087	:	DECISION
Filing or 371(c) Date: 11/23/1998	:	ON PETITION
Title of Invention:	:	
PASSIVE KNOTLESS SUTURE	:	
TERMINATOR FOR USE IN	:	
MINAMALLY INVASIVE SURGERY AND	:	
TO FACILITATE STANDARD TISSUE	:	
SECURING	:	

This is a decision on the petition for reconsideration under 37 CFR § 1.378(e), to reinstate the above-identified patent, filed May 7, 2007.

The petition is **DENIED**.

Background

The patent issued May 23, 2000. Patentee could have paid the three and one half (3½) year maintenance fee between May 23, 2003, and November 23, 2003, without a surcharge, or within the six (6) month grace period between November 24, 2003 and May 23, 2004. Patentee failed to do so; accordingly, the patent became expired on May 24, 2004.

The October 27, 2006, Petition, supplemented December 4, 2006

Patentee filed a petition to reinstate the above-identified patent on October 27, 2006, and supplemented December 4, 2006, wherein Petitioner explained that the law firm responsible for payment of the maintenance fee, Thelen, Reid & Priest, LLP, ("Thelen Reid"), failed to pay the maintenance fee. Petitioner also asserted that this Office also failed to Notify the Patentee that the maintenance fee was due, and that this office allowed the Patentee to file amendments in the above-identified reissue application during the period after the patent had become expired, without notifying the Patentee that the patent had expired.

The March 6, 2007 Decision dismissing the petition

A Decision dismissing the petition was mailed on March 6, 2007. The Decision informed Petitioner that the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due, and that the lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

The Decision also informed Petitioner that a delay caused by the actions or inactions of Patentee's voluntarily chosen representative, does not constitute unavoidable delay. Patentee asserted that Thelen Reid was responsible for payment of the maintenance fee, but failed to pay the maintenance fee. Patentee was informed that it may not rely upon a delay caused by the actions or inactions of Thelen Reid to support an assertion that payment of the maintenance fee was unavoidable.

Finally, the Decision noted that Attorney Todd Sharinn was responsible for the patent until March 4, 2003. Subsequently, on December 5, 2003, Patentee filed a "Change of Attorney Docket Number and Change of Address Notice," changing the correspondence address to that of Thelen Reid. Patentee has failed to account for the period of time between March 4, 2003, when attorney Sharrin's responsibility for the patent terminated, and December 5, 2003, when Patentee filed the "Change of Attorney Docket Number and Change of Address Notice." Patentee had thus failed to account for the entire delay.

The present petition for reconsiderationPreliminary issues

Petitioner files the present petition for reconsideration and initially requests clarification as to whether the renewed petition may be filed under 37 CFR 1.137 or 1.378(b), and whether extensions of time are available?

Petitioner is advised that, as language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. See *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the "unavoidable" delay standard. Regarding whether extensions of time were available, the applicable rule, 37 CFR 1.378(e), states:

Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee.

The Decision set a two (2) month period for reply, and Petitioner timely filed the present request for reconsideration.

Petitioner also takes issue with the statement in the petition that the showing of unavoidable delay must include the showing from the time the payment was due, May 24, 2004, through the filing of a grantable petition. Petitioner asserts that May 24, 2004 was the date that the patent expired, not the date that the payment was due. Petitioner asserts that the error in the citing of the significance of these dates renders the entire decision subject to question.

As Petitioner correctly notes, May 24, 2004 was the date that the patent expired. Petitioner is advised that, had the payment been received on May 23, 2004, the patent would not have expired. While the three and one-half (3½) year maintenance fee due date is the date the maintenance fee is to be paid, this Office extends a six (6) month grace period such that the patent does not expire until six (6) months after the due date. "Unless payment of the applicable maintenance fee is received in the United States Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period." See 35 U.S.C. § 41(b)

Further to this, 37 CFR 1.378, Acceptance of delayed payment of maintenance fee in expired patent to reinstate patent, states:

(a) The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable (paragraph (b) of this section) or unintentional (paragraph (c) of this section) and if the surcharge required by § 1.20(i) is paid as a condition of accepting payment of the maintenance fee.

Finally, 37 CFR 1.137, Revival of abandoned application, terminated reexamination proceeding, or lapsed patent, states in relevant part that the showing required must include (a) (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable;

Accordingly, the showing of unavoidable delay required under 37 CFR 1.378(b) runs from the due date for the reply – the day after which the patent is expired - to the filing of a grantable petition.

Petitioner next disagrees with the Decision's conclusion that Sharinn's responsibility concluded on March 4, 2003, and that there is no objective evidence to support this conclusion.

A review of the Supplement to Petition filed December 24, 2006 reveals that Petitioner herein filed a Statement in Support of Petition Under 37 C.F.R. 1.378(b) executed by Todd Sharinn wherein Mr. Sharinn states on page two that

[m]y responsibility, including the payment of any maintenance fee that may become due, for the subject patent ended prior to the date where payment of a first maintenance fee was due as evidenced by the enclosed Revocation of Prior Powers of Attorney signed on

the behalf of Quickie, LLC, on March 4, 2003 wherein 'all powers of attorney previously given [were] hereby revoked.'

Statement of Mr. Sharinn at p.2.

The patent expired on March 24, 2004. The relevant period is the period between March 24, 2004 and the filing of a grantable petition.

The response to the Decision

As to the Decision, Petitioner states that the delay was unavoidable because at all relevant times, Thelen held Petitioner's general power of attorney and Greenberg/Sharinn were the designated recipients of all office communications concerning maintenance fees on the '160 Patent. In light of these facts, Petitioner states that "it is self-evident that Petitioner was reasonably looking to its outside counsel to handle maintenance fees on the patent, and thus the failure to pay the maintenance fees was unavoidable to petitioner." Request for Reconsideration at p.4.

Petitioner asserts that the responsibility to present a complete record due to the failure to obtain the client files and other documents related to the representation of his client Thelen and Greenberg fall squarely at the feet of Thelen and Greenberg. Petitioner requests, at a minimum, additional time to produce documents from Thelen and Greenberg.

Applicable Law, Rules and MPEP

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900,

16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder does not constitute unavoidable delay. See Patent No. 4,409,763, *supra*. See also Final Rule entitled “Final Rules for Patent Maintenance Fees,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee’s agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962); *Huston v. Ladner*, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also *Haines v. Quigg*, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner’s delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm’r Pat. 130, 131 (Comm’r Pat. 1891). *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff’d*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm’r Pat. 139, 141 (1913).

Opinion

Petitioner/Patentee is advised that it is immaterial to reinstatement of the patent as to whether the actions or inactions of Thelen, Greenberg, Sharinn, or any other voluntarily chosen representative of the Patentee resulted in the failure to timely pay the maintenance fee. A delay caused by the actions or inactions of Patentee's voluntarily chosen representative, does not constitute unavoidable delay. Patentee may not rely upon a delay caused by the actions or inactions of a voluntarily chosen representative to support an assertion that payment of the maintenance fee was unavoidable. As the court stated in Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987), Plaintiff

cannot, however, ask the court to overlook Attorney Knoblock's action or inaction with regard to the patent application. He hired Knoblock to represent him; Knoblock's actions must be imputed to him. *Link v. Wabash Railroad Co.*, 370 U.S. 626, 633-34, 82 S. Ct. 1386, 1390-91, 8 L. Ed. 2d 734 (1962) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'"); *Inryco, Inc. v. Metropolitan Engineering Co., Inc.*, 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions."). See also, e.g., *Wei v. State of Hawaii*, 763 F.2d 370, 372 (9th Cir. 1985); *LeBlanc v. I.N.S.*, 715 F.2d 685, 694 (1st Cir. 1983).

Lastly, as to Petitioners request for, at a minimum, additional time to produce documents from Thelen and Greenberg Petitioner is advised that, as stated in 37 CFR 1.378(e), "[a]fter the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director."

Decision

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of March 6, 2007 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.



Charles Pearson
Director
Office of Petitions